UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DAVID L. KAMINSKY and DAVID M. OGLE

_____

Appeal 2009-002078
Application 10/654,786
Technology Center 2400

_____

Decided: October 28, 2009

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Before LANCE LEONARD BARRY, JEAN R. HOMERE, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the

Examiner's rejection of claims 1, 9, 15, 28, and 29. Claims 2-8, 10-14, and

16-27 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

The invention relates to techniques for managing instant messages, including the display of windows for incoming messages, and status information for instant messaging users (Spec. 2, ll. 1-2).

Independent claim 1 is illustrative:

>   1. A method of using policy information in responding to arrival of instant messages, comprising:
>
>>   defining, by an instant messaging ("IM") user, policy information specifying criteria for responding to arrival of instant messages, wherein the policy information comprises a list of selected application programs which are each distinct from an instant messaging application used by the IM user and which are each executable on a computing device of the IM user;
>>
>>   receiving an instant message from an IM sender who is not already participating in an IM session with the IM user;
>>
>>   programmatically determining, responsive to the receiving, whether any of the selected application programs in the list are currently executing on the computing device of the IM user; and
>>
>>   responding to the arrival of the instant message by opening a new window on a graphical user interface of the computing device of the IM user and displaying the instant message therein if the programmatically determining has a negative result, or by adding an icon representing the instant message to an already-open window but not displaying the instant message itself if the programmatically determining has a positive result, wherein:

the already-open window comprises one of an already-open buddy list window that visually depicts a list of each IM partner from an IM address book of the IM user or an already open status window that visually depicts a list of each currently-active IM partner of the IM user;

the icon is added in association with a representation, in the visually-depicted list, of the IM sender; and

the icon visually indicates that the instant message is available for on-request display and can be activated by the IM user to cause the on-request display of the instant message.

References

The Examiner relies upon the following references as evidence in support of the rejection:

Brown	US 2003/0055908 A1	Mar. 20, 2003
Horvitz	US 2003/0046421 A1	Mar. 6, 2003
Green	US 2004/0172455 A1	Sep. 2, 2004

Rejection

Claims 1, 9, 15, 28, and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown, Horvitz, and Green.

ISSUE 1

Appellants argue that they "find no discussion or suggestion in Brown of . . . policy information compris[ing] a list of selected application programs . . . which are each executable on a computing device of the IM user" (App. Br. 8). They argue that Horvitz is not appurtenant because

"their claimed 'list of selected application programs' is <u>not</u> 'dynamically created by the system'" (App. Br. 9). Appellants also argue that "Claim 1 does not recite use of 'priority' requirements" (App. Br. 8).

Issue: Did Appellants demonstrate that the Examiner erred in finding that the combination of the Brown, Horvitz, and Green references teaches user-defined policy information comprising a list of selected application programs which are each executable on a computing device of the instant message user?

<div align="center">ISSUE 2</div>

Appellants argue that they "find no discussion or suggestion in Brown of . . . programmatically determining . . . whether any of the selected application programs in the list are currently executing" (App. Br. 8). They argue that Horvitz is not appurtenant because "Claim 1 recites '. . . whether <u>any</u> of the selected application programs in the list <u>are currently executing</u>'" (App. Br. 9). They also identify several teachings in Horvitz, arguing that none of them teach "whether any of the selected <u>application programs</u> in the list are currently executing" (App. Br. 10-15).

Issue: Did Appellants demonstrate that the Examiner erred in finding that the combination of the Brown, Horvitz, and Green references teaches programmatically determining whether any of the selected application programs in a list are currently executing?

<center>ISSUE 3</center>

Appellants argue that "the user might be focused on the user's <u>instant messaging application</u>, which is explicitly excluded from the list under consideration" (Reply Br. 7).

Issue: Did Appellants demonstrate that the Examiner erred in finding that the combination of the Brown, Horvitz, and Green references teaches policy information that comprises a list of selected application programs which are each distinct from an instant messaging application used by the instant message user?

<center>FINDINGS OF FACT</center>

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

1. Brown teaches "[a] priority settings database 61 [that] includes priority settings for each user [where] a user may designate variables for which bonuses may be added to priority values" (¶ [0066]), where a "[p]riority controller 62 [is used to] determine priority requirements for message requests [and] determine whether message requests meet the priority requirements" (¶ [0067]).

2. Brown teaches that bonus settings can be selected for users, subjects, and groups (¶¶ [0094-0097]; fig. 9). These bonus settings may include variations based on criteria such as time and activity with other users (*id.*).

<center>5</center>

3. Horvitz teaches

a system and methodology to enable a plurality of
information associated with electronic messages, for
example, to be automatically prioritized by a priorities or
message urgency system for subsequent transmittal to a
user or system. The priorities system can utilize
inferences systems such as probabilistic classifiers or
other methods for interpreting messages that can be
explicitly and/or implicitly trained to prioritize one or
more received messages according to a learned
importance to the user.

(¶ [0062]).

4. Horvitz teaches that "[s]everal classes of evidence can be
employed to assess a user's activity or his or her focus of
attention" (¶ [0263]), including recent application history and
the application in focus (fig. 34).

5. Appellants cite to the Specification in summarizing the
limitation of "[programmatically] determining whether any of
the applications from list are currently executing" (App. Br. 3).
Where cited, the Specification includes "[a]s examples of using
dynamic criteria, [that] the user might define a policy that pops
up a new IM window for arriving instant messages except when
one of a list of selected applications is currently active on the
recipient's computing device" (Spec. 12, ll. 7-9).

PRINCIPLES OF LAW

Claim interpretation

"In the patentability context, claims are to be given their broadest reasonable interpretations." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

"Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention . . . ." *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Thus, a "factfinder should be aware . . . of

the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *KSR Int'l Co. v. Teleflex, Inc.* 550 U.S. at 421.

ANALYSIS

Issue 1

An obviousness rejection, based on the combination of Brown, Horvitz, and Green, cannot be reversed by attacking either Brown or Horvitz individually. Brown teaches user-designated message priority adjustment settings (defining, by an instant message user, policy information specifying criteria for responding to arrival of instant messages) (FF 1). These settings can be based on a variety of criteria (FF 2).

Horvitz also teaches message prioritization (FF 3). In Horvitz, several classes of evidence can be used to assess a user's activity level (FF 4). This evidence can include recent application history and the application in focus (i.e., application programs currently executing) (FF 4). The message prioritization system of Horvitz can be can be explicitly trained (FF 3), thus producing a list of selected executable application programs. An artisan of ordinary skill would have found it obvious to extend the variety of criteria in Brown with the list of selected executable application programs taught by Horvitz.

Appellants argue that one of the paragraphs in the Examiner's answer "clearly suggests a <u>prohibited hindsight reasoning</u> approach to evaluating Appellants' claim language" (Reply Br. 6). This argument is not persuasive.

The prohibition against reliance on hindsight reasoning does not depend on the subjective state of mind of the Examiner. If the Examiner's state of mind were dispositive, no obviousness rejection could be sustained; patent examinations are conducted with complete knowledge of the applicant's invention. *See In re* Oetiker, 977 F.2d at 1447.

Hindsight reasoning is only consequential based on an objective test: whether an artisan of ordinary skill in the art would have found it obvious to combine or modify the prior art, as suggested by the Examiner, without the benefit of hindsight knowledge. Appellants have not proffered arguments or evidence of anything other than the Examiner's state of mind. Moreover, both Brown and Horvitz teach message prioritization systems (FF 1, 3). An artisan of ordinary skill possessing creativity and common sense would not require hindsight to realize that the classes of evidence taught by Horvitz (FF 4) could be added to the classes of evidence used in Brown (FF 2).

We are also not persuaded by Appellants' argument that "Claim 1 does not recite use of 'priority' requirements" (App. Br. 8). Appellants provide no arguments or evidence demonstrating that settings for adjusting message request priorities do not fall within a reasonably broad interpretation of policy information specifying criteria for responding to arrival of instant messages.

For at least these reasons, we find that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's 35 U.S.C. § 103(a) rejections of claims 1, 9, 15, 28, and 29 with respect to this issue.

Issue 2

Appellants' arguments regarding Brown are not appurtenant. The Examiner relies on Horvitz, not Brown, for the teaching of programmatically determining whether any of the selected application programs in the list are currently executing (Ans. 3-4).

We are not persuaded by Appellants' arguments that Horvitz does not teach programmatically determining "whether <u>any</u> of the selected application programs in the list <u>are currently executing</u>" (App. Br. 9). The Specification does not clearly define what it means to programmatically determine whether any selected application programs in a list are currently executing. The Specification does not even use the term "currently executing." Instead, it refers to determining whether an application is "currently active" (FF 5). The Specification also does not provide a special meaning for "programmatically determining" (FF 5).

The Specification must make the special meaning of claim terms sufficiently clear to be understood by an artisan with experience in the field of the invention. *See Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d at 1477. The Specification lacks a clear definition for "currently executing" and "programmatically determining" is not given a special definition. Therefore, we find that the Horvitz teachings of obtaining evidence of recent application history or identifying the application in focus fall within a reasonably broad interpretation of programmatically determining whether any of the selected application programs in a list are currently executing (FF 4).

Appellants enumerate additional teachings in Horvitz, arguing that they do not teach "whether any of the selected <u>application programs</u> in the list are currently executing" (App. Br. 10-15). We do not find this argument persuasive. Horvitz teaches several classes of evidence that can be used to assess a user's activity or focus of attention (FF 4). The Examiner's rejection does not require all classes of evidence be related to programmatically determining whether an application program is currently executing.

For at least these reasons, we find that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's 35 U.S.C. § 103(a) rejections of claims 1, 9, 15, 28, and 29 with respect to this issue.

Issue 3

Appellants also do not show how explicit exclusion of the instant messaging application from the list under consideration provides a patentable distinction over the prior art. In a system created using the teachings of Brown, Horvitz, and Green, the instant message application can be readily excluded from the list of selected application programs by not selecting it. Appellants have not shown that an artisan of ordinary skill possessing creativity and common sense would mandate inclusion of the instant message application in the list of selected application programs. Moreover, if the instant messaging application is currently executing, then the user can probably manage incoming instant messages. Thus, an artisan

of ordinary skill would find it obvious to exclude the instant messaging application from the list of selected application programs.

For at least these reasons, we find that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's 35 U.S.C. § 103(a) rejections of claims 1, 9, 15, 28, and 29 with respect to this issue.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not demonstrated:

1. that the Examiner erred in finding that the combination of the Brown, Horvitz, and Green references teaches user-defined policy information comprising a list of selected application programs which are each executable on a computing device of the instant message user (Issue 1);

2. that the Examiner erred in finding that the combination of the Brown, Horvitz, and Green references teaches programmatically determining whether any of the selected application programs in a list are currently executing (Issue 2); and

3. that the Examiner erred in finding that the combination of the Brown, Horvitz, and Green references teaches policy information that comprises a list of selected application programs which are each distinct from an instant messaging application used by the instant message user (Issue 3).

DECISION

We affirm the Examiner's decisions rejecting claims 1, 9, 15, 28, and 29 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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